

Application No. 09/542,243
Amendment dated December 17, 2003
Reply to Office Action of September 18, 2003

R E M A R K S AND ARGUMENTS

Applicant wishes to thank the Examiner for considering the present application. In the Office Action dated September 18, 2003, the Examiner has acknowledged receipt of the appeal brief and has indicated that upon further consideration, he is withdrawing the finality of the previous Office Action. It is therefore assumed (and the Examiner is requested to confirm) that the Appeal has been withdrawn and normal prosecution is being resumed.

Claims 1-16 were withdrawn pursuant to a restriction requirement and were previously cancelled without prejudice to filing a divisional application therefor. Claims 17 was previously cancelled without prejudice. Claims 23 and 39 have been herein canceled without prejudice. New claims 67-70, fully supported by the original specification are presented. Claims 21, 29 and 57 have been herein amended to clarify aspects of certain recited elements, not for reasons of patentability but for purposes of further clarification; therefore, the amendments are not considered to be narrowing amendments.

Claims 21 and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Times of London* article in view of *Oliver* (6,166,329) and *McDonald* (6,335,753) and *DeMarre* (6,037,912). *Oliver* and *McDonald* and *DeMarre* are being applied in a manner similar to that in prior Office Action(s).

In this Office Action, the *Times of London* article is being added as the primary reference to the combination applied in the earlier Office Action. Comments made concerning the *Oliver* and *McDonald* and *DeMarre* references in previous responses are still applicable and, therefore, will not be repeated again for the most part. Claim 21 is an independent claim with claims 18-20 dependent therefrom.

The *Times of London* article describes a house that "is pre-wired to run a network of computers, satellite, and digital TV and CCTV". The article identifies a "Connect Home Integrated Entertainment and Information System" that supposedly "enables the owner to watch cable, satellite, video and terrestrial TV from any TV in the house". The teachings of the *Times of London* article are highly deficient. The Examiner admits that the *Times of London* article "does not teach specifically the satellite wires positioned adjacent to the plurality of studs and coupled to drywall layer and having first, second terminations, radome enclosing the first termination, a

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connector coupled to the second termination". It appears that, except for the description about the home being "pre-wired to run a network of computers, satellite and digital TV and CCTV", the Examiner is relying on the secondary references as allegedly suggesting the elements recited in the claims in question.

Not only is the *Times of London* article deficient in many respects, it specifically identifies a "Connect Home Integrated Entertainment and Information System" as enabling the owner to watch cable, satellite, video and terrestrial TV from any TV in the house. Details of the system are not provided in the article. However, it is clear that this system is important and critical, perhaps central to the functionality of the house. In the face of such indication, even if the deficiencies of the *Times of London* article are cured by the proposed combination as alleged by the Examiner, the combined system neither teaches nor suggests the present invention since an important aspect of the *Times of London* article house appears to be this "Connect Home Integrated Entertainment and Information System".

It is further submitted that the proposed modification or combination of the prior art would change the principle of operation of the *Times of London* article house, and therefore, the teachings of the references are not sufficient to render the claims *prima facie obvious*. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Furthermore, the *Times of London* article teaches away since it puts forth a very specific approach to address a very specific problem that neither teaches nor suggests claims 21 and 18-20 nor is it addressing at least one of the problems that the claimed invention is addressing. As discussed on page 2 lines 1-9 of the specification, many multi-unit condominiums, apartment complexes and housing developments are subject to strict association regulations governing use of conventional satellite antennas for reception of satellite based services. Apartment building owners have also been known to impose restrictions that prevent tenants from mounting satellite dishes on the roof or the balcony of their respective units. Conventional satellite dishes are parabolic antennas that protrude from the roof or the side of the house and many association regulations either do not allow installation of such antennas or place restrictions. This has been a big problem not only for satellite TV broadcasters but also for potential customers. None of the applied references are addressing this particular problem nor are they presenting solutions to this problem.

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The present application by providing "a low-profile radome for housing a satellite antenna, enclosing said first termination and disposed contiguous with a surface of the satellite ready building" as presently recited in independent Claim 21 addresses this long-felt need. The low-profile of the radome and disposition on a surface of the building avoid the protrusion of conventional satellite dishes. This reduction of visual intrusion should enhance market acceptance by customers and meet the requirements of relevant regulations of multiple unit, condominium, apartment and housing associations and other entities and thereby meet a long-felt need. This secondary indicia of non-obviousness is note-worthy and significant.

The *Times of London* article is devoid of any teaching concerning radomes, flat satellite antennas housed therein for reception of satellite signals, or considerations relating to apparatus for satellite TV reception that do not protrude or run afoul of various multiple-unit building regulations.

It is well-established that teachings of references can be combined only if there is some suggestion, teaching or motivation to combine the references. In the Office Action, the motivation for the combination appears to be provided merely by the allegations of the Examiner that the proposed combination would have been obvious to one of ordinary skill in the art and by conclusory statements unsupported by the references themselves.

For example, on page 3 of the Office Action, the Examiner alleges that at "the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the Time of London article with Oliver's for the plurality of studs and drywall adjacent to the pre-wiring and with McDonald for satellite antenna connections and with DeMarre for antenna enclosing by the radome 104. *The motivation for substituting the Time of London article with Oliver's pre-wiring adjacent to the plurality of studs and drywall and with McDonald's satellite wire and DeMarre would have been to provide today latest technology into new build homes or business buildings capable to access for satellite signal for uses of TV, Internet service, cellular phone, etc.* However, DeMarre does not teach specifically the radome enclosed the antenna and also the first termination, examiner considers this would have been obvious matter of rearranging parts of an invention that involves only routine skill in

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the art. *The motivation for doing would have been to protect the connection from UV radiation or water damage*" (italics added for emphasis).

It can be seen from the foregoing excerpt, that conclusory statements unsupported by the teachings of the references (expressly or by implication) are used to show motivation to combine the references and to modify the teachings of the *Times of London* article. Additionally, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F. 2d 1260, 1266 n. 14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), citing In re Gordon, 733 F. 2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Examiner has failed to show the obviousness of the combination by pointing out objective teaching in the prior art and, instead, attempts to carry his burden by alleging that knowledge generally available to one of ordinary skill in the art would lead the individual to selectively pick and choose various teachings from the multiple cited references. However, it is respectfully submitted that his attempts fail to satisfy the burden of showing obviousness of the combination since it is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against the teacher." See In Re Lee, 277 F.3d 1338, 61 USPQ2d 1430,1434 January 18, 2002, quoting W. L. Gore v. Garlock, Inc., 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). None of the references are addressing the particular problem(s) that the present application addresses and, therefore, do not provide the motivation, suggestion or incentive to combine. It is only with impermissible hindsight gained from the teachings of the present application that the Examiner appears to be selectively picking bits and pieces from the various references to support his allegation of obviousness.

For the foregoing reasons, it is respectfully submitted that the proposed combination is improper and neither teaches nor suggests Claim 21. Claims 18-20 depend directly or indirectly from Claim 21 and are generally allowable for the same reasons as Claim 21 and further due to the additional limitations recited therein.

Claims 21-23, 25, 27, 29-39, 41-43, and 57-65 are being rejected under 35 U.S.C. §103(a) as being unpatentable over the *Times of London* article in view of *Oliver and McDonald* and *DeMarre*. Applicant respectfully traverses.

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Comments made above in connection with the rejection of Claim 21 concerning the improper combination of references and the references themselves are also generally applicable to this rejection.

With respect to the issue of solving the problem of failure of conventional satellite dishes to meet the requirements of various multiple unit building codes and regulations, Claim 29 presently recites "a first radome for housing a first satellite antenna, in conformance with a mounting surface of the building, enclosing said first termination; and a second radome for housing a second satellite antenna, in conformance with a mounting surface of the building, enclosing said third termination, wherein said first radome and said second radome are low-profile"; independent Claim 57 presently recites "a first low-profile radome disposed on the building contiguously with a surface, said first radome enclosing said first termination; and a second low-profile radome disposed on the building contiguously with a surface, said second radome enclosing said third termination". New Claim 67 also recites "multiple low-profile radomes, each for housing at least one flat satellite antenna therein and enclosing at least one of said first terminations, conformably mounted on a mounting surface of the building so as to reduce visual intrusion".

Claim 22 specifically recites "a satellite antenna positioned within said radome". As discussed in the specification, various types of flat antennas may be installed in the radome (see page 3, lines 19-20) before or after the building is completely built (see page 10, lines 14-15). Claim 25 specifically recites "a flat antenna", a solution to the problem of the conventional protruding antenna discussed above. Claim 26 recites "a remote control for positioning said antenna". As discussed in the specification, the remote control may be used to control the direction of the antenna if a moveable beam is used (see page 8, lines 19-20).

The preamble of independent Claim 29 and dependent claims 30-38 and 41-43 recites a "multiple unit building", and the preamble of independent claim 57 and dependent claims 58-65 recite a "multiple-unit satellite ready building". With regard to Claims 29-37, 39, 41-43 and 57-64, on page 5 of the Office Action, the Examiner alleges that it would have been obvious "to have more than one radomes and satellite wires connecting to more than one terminations, since it has been held that mere duplication of the essential working device involves only routine in the art". In this

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regard it is pointed out that the structure recited by these claims does not represent mere duplication. The claims address the problems faced by occupants of multiple unit buildings with respect to building and association regulations as discussed above and provide the occupants of the multiple units with the ability to use the television or computer in the various rooms of each unit of the multiple units in the building without having to *individually* apply for permits to install satellite TV dishes, install satellite wiring and connections, etc. This results in cost advantages and promotes distribution of satellite TV by reducing the barriers to entry and installation. All these factors argue against dismissing these claims as "mere duplication".

In addition to the foregoing, generally for the same reasons discussed above in connection with Claim 21 and further due to the limitations recited therein, it is submitted that Claims 21-22, 25, 27, 29-38, 41-43, and 57-65 are allowable over the cited references. Claims 23 and 39 have been herein cancelled without prejudice.

Claims 24, 40, and 66 are being rejected under 35 U.S.C. §103(a) as being unpatentable over the *Times of London* article in view of *Oliver and McDonald* and *DeMarre and Radov* (4,710,778).

Comments made concerning the improper combination of references and the references hereinabove and earlier responses are also generally applicable to this rejection.

Claims 26, 28, 38, and 65 are being rejected under 35 U.S.C. §103(a) as being unpatentable over the *Times of London* article in view of *Oliver and DeMarre and Spano* (6,204,823) and *Iwamura* (5,940,028).

Comments made concerning the improper combination of references and the references hereinabove and in earlier responses are also generally applicable to this rejection.

It is noted that although independent claim 44 is included in the identification of rejected claims 18-66 in the Summary page of the Office Action, it has not been specifically rejected over art in the body of the Office Action. This was also pointed out in the earlier Appeal Brief. Therefore, it is assumed that Claim 44 is allowed. Therefore, dependent Claims 45-56 should also be allowed. Instead, Claims 45-56 are being rejected under 35 U.S.C. 103(u) as being unpatentable over *the Times of London article, Oliver and DeMarre and Spano and Iwamura*. Again, comments made

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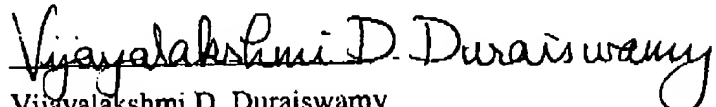
concerning the improper combination of references and the references hereinabove and in earlier responses are also generally applicable to this rejection.

New claims 67-70 particularly focus on certain aspects of the invention and are neither suggested nor shown by the cited references and are believed to be allowable.

With respect to the *Times of London* article, Applicant's arguments presented here should not be deemed to be an admission that it is prior art and Applicant reserves all rights to argue, including, the right to swear back of the reference.

In light of the above amendments and remarks, Applicant submits that the rejections are now overcome. Applicant has added no new matter to the application by these amendments. The application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments that would place the application in better condition for allowance, he is respectfully requested to call the undersigned attorney at the below-listed number.

Respectfully submitted,


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